

**MAILED**

FEB 01 2002

**DIRECTOR'S OFFICE  
TECHNOLOGY CENTER 2100**

Paper No. 10

Kirk Wong  
Law Offices of Michael A. Glenn  
3475 Edison Way, Ste. L  
Menlo Park, California 94025

In re Application of: )  
Johnson )  
Application No.: 08/960,755 )  
Filed: October 29, 1997 ) **DECISION ON PETITION UNDER 37**  
For: METHOD AND SYSTEM FOR ) **C.F.R. § 1.181 TO WITHDRAW**  
CONSOLIDATING AND ) **HOLDING OF ABANDONMENT**  
DISTRIBUTING INFORMATION )

This is a decision on the petition filed June 11, 2001 under 37 CFR § 1.137(b) to revive an abandoned application. The petition is being treated as a petition under 37 CFR § 1.181(a) to withdraw the holding of abandonment of the above-identified application.

This application was held abandoned for failure to respond in a timely manner to the Office Action mailed February 19, 1999. In the apparent absence of a response to the February 19, 1999 communication, the application was held abandoned and a Notice of Abandonment was mailed September 27, 1999.

Petitioner states that a complete response to the February 19, 1999 communication was in fact timely filed. To support this assertion, petitioner has submitted a copy of a return postcard which acknowledges receipt by the U.S. Patent and Trademark Office (USPTO) on August 02, 1999. The petition also includes copies of a petition for extension of time and an amendment.

The original response, acknowledged as having been received in the USPTO on August 02, 1999 is not of record in the application file and cannot be located. However, M.P.E.P. § 503 states that "A post card receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO." The postcard indicates that the response includes a petition for an extension of time and an amendment.

In reviewing the petition and the attached copies of the postcard receipt, the petition for extension of time and an amendment, it is noted the papers were timely filed, but with an incorrect application

serial number 08/968,755. The correct application serial number should be --08/960,755--.

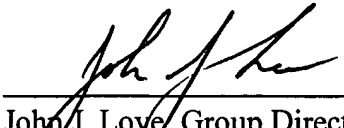
Under current Office procedure, a response that has an incorrect application number is handled in accordance with MPEP § 508.03. If a paper having an incorrect application number contains sufficient information to identify the correct application and was timely filed, the holding of abandonment will be withdrawn. In reviewing the papers submitted, it is concluded that the information contained thereon, includes name of the inventor, filing date of the application, title of the invention and the name of an examiner in the TC thereon which is deemed sufficient to associate the papers with the instant file.

The Notice of Abandonment was mailed September 27, 1999, and the petition was not filed until June 11, 2001. MPEP § 711.03(c)(I) states in part that "... 37 CFR 1.181(f) provides that, inter alia, except as otherwise provided, any petition not filed within 2 months from the action complained of may be dismissed as untimely. Therefore, any petition (under 37 CFR 1.181) to withdraw the holding of abandonment **not filed within 2 months** of the mail date of a notice of abandonment (the action complained of) may be dismissed as untimely. 37 CFR 1.181(f). **Rather than dismiss an untimely petition to withdraw the holding of abandonment** under 37 CFR 1.181(f), the Office may treat an untimely petition to withdraw the holding of abandonment on its merits on the condition that ... The Office may treat an untimely petition to withdraw the holding of abandonment on its merits in a utility or plant application filed on or after June 8, 1995, on the condition that the petition is accompanied by a **terminal disclaimer** dedicating to the public a terminal part of the term of any patent granted thereon that would extend beyond the date 20 years from the filing date of the application, or the earliest application to which the application specifically refers under 35 U.S.C. 120, 121, or 365(c). In either case, the terminal disclaimer must also apply to any patent granted on any application that claims the benefit of the filing date of the application under 35 U.S.C. 120, 121, or 365(c). Such a terminal disclaimer is not required under 37 CFR 1.137(d) because abandonment of an application is a per se failure to exercise due diligence, and as such, an applicant cannot obtain patent term extension under 35 U.S.C. 154(b) due to prosecution delay caused by abandonment of the application. Where a petition to withdraw the holding of abandonment is granted, the application is considered to never have been abandoned and, as such, the prosecution delay caused by the treatment of the application as abandoned is not considered a per se failure to exercise due diligence. Thus a terminal disclaimer is required to avoid granting patent term extension under 35 U.S.C. 154(b) due to prosecution delay caused by the treatment of the application as abandoned."

For the above stated reasons, the petition is **GRANTED**. The terminal disclaimer filed June 11, 2001 has been entered and the Notice of Abandonment is hereby withdrawn.

Since the petition under 37 CFR 1.181(a) to withdraw the holding of abandonment does not require a fee, the fee of \$620 to revive an abandoned application will be credited to applicant's representative Deposit Account 07-1445.

The application file is being forwarded to the Examiner for appropriate action.



---

John J. Love, Group Director  
Technology Center 2100  
Computer Architecture, Software,  
and Electronic Commerce